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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/592,660	06/13/2000	Neil W. Black	03797.86776	7450

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EXAMINER

POINVIL, FRANTZY

ART UNIT

PAPER NUMBER

3628

DATE MAILED: 05/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/592,660	<b>Applicant(s)</b> BLACK ET AL.	
	<b>Examiner</b> Frantzy Poinvil	<b>Art Unit</b> 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 2/22/06.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11, 17-28 and 30-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 17-28 and 30-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

1. The 35 USC 101 rejection has been withdrawn in view of the applicant's arguments found in the response filed 2/22/2006. The Examiner had made an updated search and therefore is obliged to issue a rejection as found below. The Examiner regrets the delayed process of the application.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 5 and 17-18 are rejected under 35 U.S.C. 102(b) as being anticipated by "Mutual Fund Investor's", Center, WWW.MFEA.com.

As per claims 1 and 17, Mutual Fund Investor's Center discloses all the claimed invention particularly, a computer-implemented method for creating a portfolio comprising:

Receiving user input via a computer identifying specific issues to be added to the portfolio (the article indicates issues to be added such as "Load", "Minimum Required Investment Amount" and "the type of fund to select").

Receiving user input via a computer input indicating a selection of one of a plurality of options for creating the portfolio (see pages 3 and 4 of the article);

Receiving computer-input indicating a past date for purchase of the portfolio (see page 1 where the user can enter a past year date in creating the portfolio);

Creating the portfolio and calculating the portfolio's past performance, using a computer based on said selection of one of said plurality of options and the past date. See page 2 for the selection of the insertion of a desired date.

The user will click on the "My Portfolio" button for the creation of the portfolio.

As per claims 2 and 18, the article or website shows receiving computer input indicating the selection includes receiving computer input indicating a selection of an option to allocate a number of shares for each issue. See pages 1-3 of the article.

As per claim 5, the number of shares for each issue is based on a weighting factor as calculated by the system of the Mutual Fund Investor's Center. See pages 1-4 of the article.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 4, 6-11, 19-28 and 30-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Mutual Fund Investor's", Center, [WWW.MFEA.com](http://WWW.MFEA.com) in view of "O'Shaughnessy et al. (US Patent No. 5,978,778).

As per claims 3, 6-8, 10, 19 and 21-24, the teachings of the Mutual Fund Investor's Center are discussed above in the noted article. The article does not explicitly state the number of shares is constant, a selection of an option to allocate an equal amount for the purchase of each issue and wherein the equal amount is selected by a user or the amount is equally divided between the issues. As per these limitations, O'Shaughnessy et al teach the number of shares is constant for each issue and the selection includes receiving via a computer indicating an option to allocate an equal amount for the purchase of each issue and wherein the equal amount is selected by the user. See column 14, lines 22-28 and column 16, lines 52-58.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate these features in the system of the Mutual Fund Investor's Center as taught by O'Shaughnessy et al. in order to provide a client or user with a wide range of choices in creating the portfolio.

As per claims 4 and 20, the teachings of "Mutual Fund Investor's", Center, [WWW.MFEA.com](http://WWW.MFEA.com) are discussed above. The article does not explicitly state the number of shares is not constant for each issue. However, the Examiner notes that such would have been left to the user or investor. O'Shaughnessy et al suggest such. Thus, providing such a feature in the system of Mutual Fund Investor Center and O'Shaughnessy et al would have been obvious to one of ordinary skill in the art in order

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to place a desired quantity of shares in the portfolio for each issue when placing a complete order or when creating the portfolio.

As per claims 7 and 23, O'Shaughnessy et al disclose said receiving computer input indicating the selection includes receiving computer input indicating a selection of an option to allocate a total amount for the portfolio. See column 14, lines 22-28 of O'Shaughnessy et al.

As per claims 9 and 25, it is not explicitly sated in the article that the amount is not equally divided between the issues in the combination of Mutual Fund Investor and O'Shaughnessy et al. It would have been obvious to one of ordinary skill in the art at the time the invention was made to divide the amount unequally between the issues in the Mutual fund Investor's Center and O'Shaughnessy et al as such would have been dependent on the user when placing an order or creating the portfolio.

As per claims 26, the number of shares for each issue is based on a weighting factor as calculated by the system of the Mutual Fund Investor's Center. See pages 1-4 of the article.

As per claims 11 and 27, O'Shaughnessy et al disclose providing a historical purchase price for each for each specific issue in the portfolio is obtained by the

computer from a historical database based on the past date. Note column 5, lines 35-57 and column 4, lines 7-25 of O'Shaughnessy et al.

As per claims 28, 30 and 34, in the Mutual Fund Investor's Center, there includes a system for creating a portfolio when a client at a user terminal being connected to a web site or server. The system comprising:

An input system for receiving a designation of issues, for receiving a designation of an option for creating the portfolio selected from a plurality of options, and receiving a historical price associated with each of said issues (see the enclosed pages associated with the web site) ;

And a processor at the server for determining the number of shares of the issues to add to the portfolio and past performance data relating to the portfolio based on the designated option. The web site does not explicitly show the historical price associated with each of the issues. This is taught on column 14, lines 22-59 of O'Shaughnessy et al. It would have been obvious to one of ordinary skill in the art at the time the invention was made to introduce the selection of a historical price associated with an issue as taught by O'Shaughnessy et al in the system in order to provide a user to view the performance of various issues thus allowing the user to make a wise decision in creating a portfolio.


As per claims 31-33 and 35-37, O'Shaughnessy et al disclose storing the portfolio on a client computer since the client or investor is making the selection for creating the portfolio.

**Conclusion**

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantzy Poinvil whose telephone number is (571) 272-6797. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sam Sough can be reached on (272) 571-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**Frantzy Poinvil**  
**Primary Examiner**  
**Art Unit 3628**

FP  
May 12, 2006